

**REMARKS**

The Final Office Action dated April 15, 2005, has been received and reviewed.

Claims 1-29 are currently pending and under consideration in the above-referenced application. Of these, claims 1-22 have been allowed. The Office has also indicated that the subject matter recited in claim 29 is allowable. Claims 23-28 stand rejected.

Reconsideration of the above-referenced application is respectfully requested.

**Rejections Under 35 U.S.C. § 102**

Claims 23-26 and 28 stand rejected under 35 U.S.C. § 102(e) for reciting subject matter which is purportedly anticipated by that described in U.S. Patent 6,426,565 to Bhatt et al. (hereinafter "Bhatt").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Drawings can only be relied upon "for what they reasonably disclose and suggest to one of ordinary skill in the art." M.P.E.P. § 2125.

The method of independent claim 23 includes, among other things, "configuring at least one terminal . . . to protrude a sufficient distance . . . to prevent excess adhesive material . . . from contaminating a connection surface of the at least one terminal."

While Fig. 2 of Bhatt illustrates a carrier substrate that is designed to include a substantially planar substrate 112 with at least one die attach location 128 on a major surface thereof, it is respectfully submitted that Bhatt does not expressly or inherently describe that the carrier substrate is designed to include at least one terminal configured to protrude a sufficient distance to prevent excess adhesive material from contaminating a connection surface of the at least one terminal.

Instead, the description of Bhatt is limited to a method for designing a carrier substrate to include a recess, referenced as "opening 116" in FIG. 2, "to substantially prevent[] adhesive 135 from contacting the plurality of conductive pads 132 on substrate 112." Col. 6, lines 33-38.

Further, although it is recognized that the simple drawings of Bhatt represent that the conductive pads 132 protrude from the major surface of the substrate 112, Bhatt does not include any specific explanation about the distance that the conductive elements 132 protrude from the major surface. Thus, the drawings can only be relied upon to show that the conductive elements 132 are configured to protrude from the major surface of substrate 112, not that the conductive elements 132 are configured “to protrude a sufficient distance . . . to prevent excess adhesive material . . . from contaminating a connection surface” of the conductive elements 132. as would be required for Bhatt to anticipate each and every element of independent claim 23.

Therefore, under 35 U.S.C. § 102(e), the method to which independent claim 23 is directed is allowable over the subject matter disclosed in Bhatt.

Claims 24-26 and 28 are each allowable, among other reasons, for depending directly or indirectly from claim 23, which is allowable.

It is respectfully requested that the 35 U.S.C. § 102(e) rejections of claims 23-26 and 28 be withdrawn.

#### **Rejections Under 35 U.S.C. § 103(a)**

Claims 27 has been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Bhatt, in view of teachings from U.S. Patent 6,448,507 to Fontecha et al. (hereinafter “Fontecha”).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 27 is allowable, among other reasons, for depending indirectly from claim 23, which is allowable.

Claim 27 is additionally allowable because the teachings of Bhatt and Fonteca do not support a *prima facie* case of obviousness against the subject matter to which claim 27 is directed. In particular, it is respectfully submitted that, without improperly relying upon the hindsight provided by the disclosure of the above-referenced application, one of ordinary skill in the art would not have been motivated to combine the teachings of Bhatt and Fonteca in the asserted manner. The teachings of Bhatt are drawn to carrier substrates that include features for receiving excess adhesive. The teachings of Fonteca are, in contrast, drawn to solder masks that are configured for use with conventional substrates (*e.g.*, circuit boards) and that include features for receiving excess adhesive. As the substrate of Bhatt already includes features for receiving excess adhesive, one of ordinary skill in the art would not be motivated to combine teachings that relate to solder masks with adhesive-receiving features with teachings from Bhatt.

Therefore, under 35 U.S.C. § 103(a), claim 27 is allowable over teachings from Bhatt and Fonteca.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections of claim 27 is respectfully requested.

#### **Allowable Subject Matter**

The allowance of claims 1-22 and the indication that claim 29 recites allowable subject matter are gratefully acknowledged. Claim 29 has not been amended to independent form because claim 23, from which claim 29 depends, is believed to be allowable.

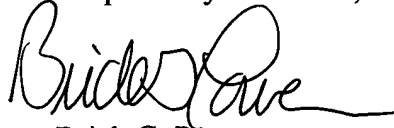
#### **CONCLUSION**

It is respectfully submitted that each of claims 1-29 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of

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the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brick G. Power", with a stylized, flowing script.

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